

The following is believed to be fully responsive to each point of rejection raised by the Examiner in the non-final Office action, dated December 2, 2002. Accordingly, Applicant respectfully requests favorable reconsideration and allowance of the pending claims.

**Rejection of Claims 1, 2, 5-9 and 25**

The Examiner has rejected claims 1, 2, 5-9 and 25 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,341,133 B1 (hereinafter Kawamoto), in view of U.S. Patent No. 6,310,609 B1 (hereinafter Morgenthaler), and further in view of U.S. Patent No. 6,473,609 B1 (hereinafter Schwartz). Applicant respectfully traverses this rejection.

Applicant notes that the Examiner did not address any of the arguments presented in Applicant's Amendment of September 17, 2002, with respect to claims 1-9 vis-à-vis Kawamoto and Morgenthaler. While Applicant recognizes that the Examiner has issued a second non-final Office action with a new grounds of rejection for claims 1, 2 and 5-9, MPEP §707.07(f)(Answer All Material Traversed)(8<sup>th</sup> Edition) states where Applicant traverses any rejection, the Examiner should answer the substance of Applicant's arguments. In this case, the grounds of rejection in this Office action are nearly identical to those set forth in the non-final Office action dated June 19, 2002, with respect to Kawamoto and Morgenthaler and claims 1, 2 and 5-9, except that the Examiner now applies Schwartz as allegedly teaching Applicant's reception means.

Accordingly, Applicant incorporates by reference herein the arguments presented in the Amendment filed on September 17, 2002. Applicant also provides the following supplemental remarks with respect to base claims 1 and 25.

**a. Detection Means/Circuit**

The Examiner maintains that Figure 14 of Kawamoto corresponds to the code detection means of claim 1 and the code detection circuit of claim 25. Applicant respectfully disagrees.

Column 13, lines 22-53, of Kawamoto, describes that Transmission Control Protocol/Internet Protocol (TCP/IP) is used as the protocol between the personal handy phone system (PHS) server 7 and the Internet server 10. However, since the connection between the communication terminal 1 and the PHS server 7 is considered as one-to-one, the IP path information does not have to be adopted.

Column 14, lines 1-21, of Kawamoto, describes that since the TCP header does not use an IP address, the TCP header is changed for communication between the communication terminal 1 and the PHS server 7. Figure 14 of Kawamoto shows information of the changed TCP header. Kawamoto describes that an ID (identifier) is prepared as a means for recognizing a virtual line and a PS-ID (personal identifier) for recognizing position information. *Id.* The header includes the data of a header length, a code bit, check sum, a window, an option and the like. *Id.*

On its face, Kawamoto fails to teach or suggest the claimed detection means of claim 1 or the detection circuit of claim 25. Kawamoto is silent as to detecting a predetermined code

indicative of the end of contents data received by the reception means.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP §2143.03 (8<sup>th</sup> Edition); In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). The grounds of rejection fail to support that Kawamoto teaches or suggests this aspect of Applicant's communication terminal. Moreover, Kawamoto, Morgenthaler and Schwartz, individually or in combination, fail to teach or suggest the detection means of claim 1 or the detection circuit of claim 25.

**b. Light-Emission Control Means/Circuit**

The Examiner maintains that Morgenthaler teaches or suggests the light-emission control means of claim 1 and the control unit of claim 25. Applicant respectfully disagrees.

Morgenthaler describes a light source that is mounted beneath each of the translucent keys so that when the light source is illuminated, the key associated with that light source will be illuminated for easy identification by the user. (Column 3, lines 56-60). To ensure the longevity of the battery, which powers the telephone, a timer may be provided which will monitor the length of time the user interface lights the keypad. (Column 4, lines 21-23). After the keypad has been illuminated for what is considered a sufficient period of time to assist the user in making menu selections, the illumination is deactivated to save battery power. (Column 4, lines 23-27). Figure 4 of Morgenthaler essentially teaches that the activation of the light occurs when a user presses a key. (See also column 6, lines 1-23).

The functional relationship between light activation and deactivation as described in Morgenthaler fails to teach or suggest the light-emission control means of claim 1 or control unit of claim 25. Indeed, Morgenthaler fails to suggest a functional relationship between the light source 230 and start of reception of data and detection of a predetermined code indicative of the end of the contents data.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP §2143.03 (8<sup>th</sup> Edition); In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). The grounds of rejection fail to support that Kawamoto teaches or suggests this aspect of Applicant's communication terminal. Moreover, Kawamoto, Morgenthaler and Schwartz, individually or in combination, fail to teach or suggest the light-emission control means of claim 1 or the control unit of claim 25.

The grounds of rejection evidence a piecemeal approach that dissects Applicant's claimed communication terminal device and overlooks the inventive contribution contained therein. When applying 35 U.S.C. § 103, the claimed invention must be considered as a whole. MPEP §2141 (8<sup>th</sup> Edition).

#### **c. Motivation to Combine**

"There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination." MPEP §2143 (8<sup>th</sup> Edition); In re Oetiker, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). The mere fact that references can be combined or modified does not render the resultant combination obvious

unless the prior art also suggests the desirability of the combination. MPEP §2143.01 (8<sup>th</sup> Edition); In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

One skilled in the art would not have been motivated to combine the teachings of Kawamoto and Schwartz for the reasons alleged by the Examiner. One skilled in the art would have recognized that Kawamoto and Schwartz describe distinct approaches that address distinct problems in the art.

The Examiner alleges that one skilled in the art would have utilized the reception means of Schwartz in the communication terminal device of Kawamoto, to provide a device that is portable and has access to the Internet, via wireless data networks. These reasons are unconvincing, because Kawamoto already provides the alleged advantages of Schwartz, in that the terminal device of Kawamoto has access to the Internet and is portable. (See Figure 1, Internet 4; Figure 5, Internet section button 56 and Figure 12, portable communication terminal). In sum, there is no reason why one skilled in the art would have identified the allegedly corresponding reception means of Schwartz for combination with Kawamoto.

Finally, assuming *arguendo*, that one skilled in the art had made the unlikely combination of Kawamoto, Morgenthaler, and Schwartz, the communication terminal resulting from this unlikely combination would not render obvious the communication terminal devices of claims 1 and 25. Put another way, such a combination would result in a communication terminal whose keys are illuminated when a user presses a key, as described by Morgenthaler.

In sum, at the time the invention was made, one skilled in the art would not have combined the teachings of these references, to achieve Applicant's claimed invention.

For at least the reasons presented above, the rejection of claims 1 and 25 should be withdrawn. Claims 2 and 5-9 should be patentable at least by virtue of their dependency.

**Rejection of Claims 10, 11, 14, 15, 17-19 and 21-23**

The Examiner has rejected claims 10, 11, 14, 15, 17-19 and 21-23 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kawamoto, in view of Morgenthaler, in further view of U.S. Application No. 5,999,827 (hereinafter Sudo). Applicants respectfully traverse this rejection.

Applicant notes that the Examiner did not address any of the arguments, as set forth in Applicant's Amendment of September 17, 2002, with respect to claims 10, 11, 14, 15, 17-19 and 21-23 vis-à-vis Kawamoto and Morgenthaler references. MPEP §707.07(f)(Answer All Material Traversed)(8<sup>th</sup> Edition) states where Applicant traverses any rejection, the Examiner should answer the substance of Applicant's arguments. In this case, the grounds of rejection in this Office action are identical to those set forth in the non-final Office action dated June 19, 2002.

Accordingly, Applicant incorporates by reference herein the arguments presented in the Amendment filed on September 17, 2002. Applicant also provides the following supplemental remarks with respect to base claims 10, 18, 21.

**a. Reception Means**

With respect to claim 10, the Examiner has acknowledged that Kawamoto and Morgenthaler fail to teach or suggest the claimed reception means. However, the Examiner

alleges that controller 47 of Sudo corresponds to the reception means and compensates for the above-mentioned deficiency, citing to column 7, lines 4-20.

Sudo fails to disclose that the allegedly corresponding controller 47 receives contents data described in a predetermined information description language. Sudo is silent as to the portable telephone 10 receiving this type of data. Applicant also notes that the card socket 43 and the subscriber card 42 of Sudo fails to correspond to the claimed plurality of cards of the reception means. (Column 7, lines 25-38).

**b. Code Detection Means**

For reasons analogous to those presented above with respect to claim 1, the cited prior art fails to teach or suggest the claimed code detection means of claim 10. No mention is made in the cited prior art of detecting a card end tag.

**c. Light Emission Control Means**

For reasons analogous to those presented above with respect to claim 1, the cited prior art fails to teach or suggest the claimed light-emission control means of claim 10.

For at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness. Therefore, Applicant respectfully requests that the rejection of independent claim 10 and dependent claims 11, 14, 15 and 17 under 35 U.S.C. § 103(a), be withdrawn.

With respect to independent claim 18, for reasons analogous to those presented above with respect to claims 1 and 10, Kawamoto, Morgenthaler and Sudo, individually or in combination, fail to teach or suggest detecting a predetermined code and stopping light-emission of method claim 18.

For at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness. Therefore, Applicant respectfully requests that the rejection of independent claim 18 and dependent claim 19 under 35 U.S.C. § 103(a), be withdrawn.

With respect to claim 21, for reasons analogous to those presented above with respect to claims 1 and 10, Kawamoto, Morgenthaler and Sudo, individually or in combination, fail to teach or suggest detecting a card end tag and stopping light-emission of display control method claim 21.

For at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness. Therefore, Applicant respectfully requests that the rejection of independent claim 21 and dependent claims 22-23 under 35 U.S.C. § 103(a), be withdrawn.

## Conclusion

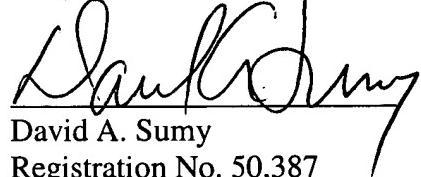
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

Response Under 37 C.F.R. § 1.111  
U.S. Application No. 09/685,770

Attorney Docket No. Q61175  
Art Unit 2674

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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